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09/885,978	06/22/2001	Praveena Varadarajan	06502.0343	5272

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EXAMINER
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FISCHETTI, JOSEPH A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/885,978

Applicant(s)

VARADARAJAN ET AL.

Examiner

Joseph A. Fischetti

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*WJ*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

Claims 6-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

Applicants' arguments have been reviewed and have resulted in the invention of Group II now including claim 17 as follows:

Group II    Claims 6, 7, 17 drawn to a method of presentment classified in class 705/40;

Since claim 18 is indefinite as it is directed to a conflicting statutory class, and cannot be grouped with claim 17, it will not be categorized at this time given this defect. Thus, category V is no longer existent in the restriction dated 2/10/04.

Applicants state it is unclear how the examiner finds distinctness. Accordingly, the following evidence is provided in support of said distinctness:

- I.        Claims 1-5, drawn to a method of billing using a separately retrieving step, classified in class 705, subclass 78;
- II.       Claims 6, 7, 17 drawn to a method of gathering billing data from a plural firms, classified in class 705, subclass 34;
- III.      Claims 8-11, drawn to computer with module, classified in class 709, subclass 223.

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- IV. Claims 12-16, drawn to a storage medium, classified in class 360, subclass 131.
- V. Claim 19, drawn to a data extraction method, classified in class 705, subclass 23.
- VI. Claim 20, drawn to a network having a host server, classified in class 709, subclass 400.

The inventions are distinct, each from the other because:

Inventions I and II-VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a method of checking consolidated scores in a non-line sports web site. See MPEP § 806.05(d).

Inventions II, and I,III-VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a method of checking on the arrival times of airlines. See MPEP § 806.05(d).

Inventions III and I,II, IV-VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as a POS station. See MPEP § 806.05(d).

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Inventions IV and I-III,V,VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as a record from which music is recorded and played. See MPEP § 806.05(d).

Inventions V, and I-IV, VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention V has separate utility such as in a data mining method which extracts customer habit data from billing data.. See MPEP § 806.05(d).

Inventions V and I-V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VI has separate utility such as in a word processing application in which the host server has resident files on which remote computers access and work on the word processed. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Regarding the arguments between Groups I and II , claim 1, contains the step of using a separately retrieving step and claims 6, 17 do not. Thus, there is two way distinctness by virtue of the different claim elements.

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Regarding the argument between Groups I and IV, a storage medium is deemed to be another statutory class. Class 360 is the class in which a storage medium, an article, is classified and hence is properly classified. Applicant's argument would appear to suggest that the storage medium claimed in Group IV above does not contain any magnetic memory component as classifiable in class 369. To cut even harder against applicant here is his failure to incorporate any technological art within claim 1 and thus give any identity of a computer implemented method.

Accordingly, the restriction is made FINAL.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims fail to incorporate any technological art sufficient to constitute application of the useful arts. Claims amended to recite implementation of the method by computer to achieve a useful tangible and would overcome this rejection.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites that a display template associated with each of the first billing entities is retrieved but that they are displayed separately. Does this mean that all the templates are displayed at once side by side or sequentially in time?

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pickering.

Pickering discloses a billing method associated with a plurality of billing entities, the method comprising: executing a single instance of a bill presentment and payment

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application (step 21); receiving at least one request from a customer (the request is read as the customer's enrollment col. 3 lines 59-65), the request identifying a first billing entity and a second billing entity (this step is deemed inherent to the step 11 which sets up by enrolling a customer against plural firms i.e., first and second billing entities); response to the request, separately retrieving and presenting to the customer stored billing data associated with each of the first billing entity and the second billing entity (step 17 discloses the utilities reporting charges to the firm 17, and whether the information is sent at a predetermined date or is sent is deemed to be a mere reversal of parts) and the stored billing data associated with each of the first billing entity and the second billing entity is retrieved and presented to the customer using the single instance of the bill presentment and payment application Step 21).

RE claim 2: Fig. 4 discloses providing bill summary information for each of the plurality of billing entities.

RE claim 3: Pickering discloses populating the fields of the individual templates (a template is read as the field extending horizontally across the screen shown in Fig 4 from each company's name); since each horizontal field segregate the data to a respective firm, this is read as "displaying separately the populated templates".

RE claim 4. Official Notice is taken regarding the old and notorious use of HTML language.



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Claims 1,3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pickering as applied to claims 1-4 above, and further in view of Hilt et al. Hilt et al disclose providing different interfaces between banks and customers depending on the needs and wants of the customers. An obvious want of any customer is to sporadically check on the status on one's account. It would thus be an obvious modification the method in Pickering to include an interface which allows one to check one's account, the motivation being the time independent need to check one's account status at will.. The implementation object is read as the symbols referred to in col. 17 line 41.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number (703) 305-0731.

*Joseph A. Fischetti*  
*Patent Examiner*  
*3627*